

REMARKS

The instant Amendment B is responsive to the second Office Action dated April 2, 2003. Amendment B is presented in the revised format authorized and described in *AMENDMENTS IN A REVISED FORMAT NOW PERMITTED*, signed January 31 and published in the *Official Gazette* on February 25, 2003.

Applicant respectfully submits that claims 1, 3-6, 8-11, 17, and 19 as set forth herein patentably distinguish over the cited references, and respectfully request allowance of all claims.

The current status of the claims

Claims 1, 5, and 6 stand rejected under 35 U.S.C. §102(b) as being anticipated by Johnson, II. (U.S. 5,580,163, hereinafter "Johnson II").

Claims 1, 2, 7, 8, 10-12, 17, and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hahnel (U.S. 5,083,253, hereinafter "Hahnel") in view of Roller (U.S. 6,414,801, hereinafter "Roller").

Claim 9 is indicated as containing allowable subject matter.

Claim 9 has been amended into independent form, and should be allowed

Claim 9 has been amended to place it in independent form incorporating the substantive elements of base claims 1, 7, and 8. As claim 9 was indicated by the Examiner as containing allowable subject matter, Applicants respectfully request an early allowance of claim 9.

The new 35 U.S.C. § 102(b) rejections of claims 1, 5, and 6 are improper and should be withdrawn

In the first office action dated November 20, 2002, claims 1, 5, and 6 were rejected as unpatentable under 35 U.S.C. § 103(a) over Johnson II in view of Larraburu (U.S. 3,302,016). In the Examiner's stated opinion, "Johnson II teaches all the structural elements of the invention except for a lens system."

In Applicants' Amendment A, claims 5 and 6 were unchanged, while claim 1 was amended only to address a formality objection by the Examiner (substituting "including" for "comprising").

In the present office action dated April 2, 2003, the Examiner now rejects claims 1, 5, and 6 as anticipated under Johnson II alone, while continuing to state that Johnson II does not disclose a lens system.

These new anticipation rejections are plainly improper. MPEP § 2131 states that "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior reference." Applicants respectfully request that the Examiner either identify the lens system in Johnson II or withdraw these new anticipation rejections.

Claim 5 has been amended to place it into independent form

Claim 5 has been amended to place it in independent form incorporating the substantive elements of base claim 1. Claim 5 presently stands rejected solely under 35 U.S.C. § 102(b) as anticipated by Johnson II. This anticipation rejection is improper, as demonstrated in the previous section.

It is unclear to Applicants whether the Examiner has withdrawn the unpatentability rejection of claims 5 and 6 asserted in the first office based on the combination of Johnson II and Larraburu. That rejection applied Johnson II as the base reference, and modified Johnson by addition of lenses disclosed in Larraburu. In the "Response to Arguments" section of the current office action, the Examiner states that Applicants' arguments in Amendment A pertaining to claim 5 are moot in view of the new grounds of rejection. However, those arguments directly addressed the Johnson II reference, which is the sole reference applied against claim 5 in the present office action.

In addressing the proposed combination of Johnson II and Larraburu in previous Amendment A, Applicants noted that the focusing mechanism of Johnson II is a tilting mechanism, rather than an axial translation mechanism. In the present office action, the Examiner acknowledges that the Johnson II focusing mechanism tilts the LEDs, but asserts that the mechanism also moves the LEDs axially.

It is not clear to Applicants that the tilt focus of Johnson II would provide incidental adjustment of a relative axial separation between the proposed added optical system and the LED module, as called for in claim 5. The proposed combination places the lenses on the outside housing **18** of the device of Johnson II. Review of FIGURES 2 and 3 of Johnson II suggests that any relative

axial motion would be less than the one-half of the axial length of the LED **34**. Such a minute axial motion, even if present, would be entirely inadequate to achieve any sort of zoom focusing effect.

Moreover, the Examiner's "Response to Arguments" completely ignores other remarks in Amendment A that point out other deficiencies in the proposed Johnson II/Larraburu combination. MPEP § 2143.01 states that "if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." As noted in Amendment A, the proposed combination would render Johnson II ineffective as a ring light with tilting focus.

MPEP § 2143.02 states that "evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness." Applicants argued in Amendment A that the proposed combination would not only be ineffective, it would be positively detrimental since the tilting of the LEDs relative to the added lenses would change the relative LED/lens axial alignment, producing distortions and other degradation of the light output.

MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." There is nothing in Johnson II or Larraburu that would motivate one skilled in the art to add lenses to the ring light of Johnson II.

The "Response to Arguments" section of the current office action also appears to suggest that the combination of Hahnel and Roller, which was applied to a number of references but not to claim 5, is viewed by the Examiner as relevant. Claim 5 calls out two sleeves that are threadedly interconnected and relatively movable in screwing fashion to selectively adjust relative axial separation of the optical system and the LED module. Neither Hahnel nor Roller disclose threadedly interconnected sleeves.

New claim 19 depends from claim 5 and calls for the LED module to be rigidly mounted on the first sleeve and the optical system to be rigidly mounted on the second sleeve. This claim further distinguishes over Johnson II in that the LEDs **34** of Johnson II are not rigidly mounted. Rather, the LEDs **34** are flexibly mounted on the flexible mount **16**.

For at least the above reasons, Applicants respectfully submit that claim 5, as well as claims 6 and 19 that depend therefrom, are in condition for allowance and request an early indication of allowance of these claims.

Claim 17 patentably distinguishes over the cited references

Claim 17 has been amended to incorporate the subject matter of canceled claim 18 specifying that the zoom apparatus includes two threadedly interconnected sleeves, the first sleeve having the light sources arranged thereon, and the second sleeve having the optical system arranged thereon.

Although Johnson II discloses threadedly interconnected sleeves, the light sources are not arranged on either sleeve, but rather are arranged on a flexible member **16** spanning between the two sleeves. Relative rotation of the two Johnson II sleeves does not effect appreciable axial motion of the light sources, but rather acts to tilt the light sources. Moreover, Johnson II does not disclose lenses, and incorporation of lenses therein would render the Johnson II device inoperable for its intended purpose as a ring light. The combination of Hahnel and Roller cannot render claim 17 unpatentable, because neither Hahnel nor Roller disclose a rotary zoom apparatus.

For at least these reasons, Applicants respectfully submit that claim 17 is in condition for allowance and request an early allowance of claim 17.

Claim 1 patentably distinguishes over the cited references

Claim 1 has been amended to incorporate the subject matter of canceled dependent claims 2 (plurality of LEDs) and 7 (inner and outer sleeves slidably interconnected), and to additionally specify that the inner sleeve is disposed inside the outer sleeve, the outer sleeve defining fixed outside dimensions of the zoom apparatus.

Hahnel does not show an inner sleeve disposed inside of an outer sleeve. Rather, Hahnel discloses two slidably interconnected sleeves that extend outside of one another. This means that the overall length of the Hahnel lamp depends upon the zoom setting. As discussed in ¶[0036] of the disclosure, the different arrangement has the advantage that with the inner sleeve disposed inside the outer sleeve, the zoom apparatus has fixed outside dimensions. This

is an important advantage for certain applications such as zoomable flashlights for which a fixed length is desirable.

Applicants therefore respectfully submit that claim 1, along with claims 3, 4, 8, 10, and 11 that depend therefrom, are in condition for allowance and request an early allowance of these claims.

CONCLUSION

For the reasons set forth above, it is submitted that all claims 1, 3-6, 8-11, 17, and 19 as set forth herein patentably distinguish over the references of record. Accordingly, an early indication of allowance is earnestly solicited.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP



Scott A. McCollister
Reg. No. 33,961
1100 Superior Avenue, Seventh Floor
Cleveland, Ohio 44114-2518
(216) 861-5582